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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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37141	7590	11/04/2005	EXAMINER	
FORTKORT GREYER + KELTON LLP 8911 N. CAPITAL OF TEXAS HWY. SUITE 3200 AUSTIN, TX 78759			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,201

Applicant(s)

VOTICKY ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 98-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 98-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's response filed on August 11, 2005. **Claims 98-118** are now pending in the present application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 98-118 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,351,764. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in continuation are broader than those in the patent. For example, claim 1, of the application does not require that code being a single desired code from the plurality of desired codes that correspond to a single known identifier form the plurality of known identifiers in the database and that corresponds to the unique identifier if the unique identifier corresponds to one of the known identifiers as recited in claim 7 of the Patent or receiving the received information message are received in claim 1 of the Patent.

Claims 98-118 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,871,217 in view of

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Scannell US Patent 5,377,354. US Patent 6,871,217 teaches everything except determining a personalized identifier corresponding to the message, wherein the personalized identifier does not require coordination between a user of the method and an originator of the message and locating the personalized identifier in a database. Scannell teaches, as shown below, determining a personalized identifier (sender field identifier) corresponding to the message, (col. 5, lines 32-39); wherein the personalized identifier does not require coordination between a user of the method and an originator of the message, (col. 7, lines 38-49) and locating the personalized identifier in a database, (col. 7, lines 38-42; the comparator 52 locates the sender identifier in the sender-list field database that matches the received sender message). Therefore, it would have been obvious to determining a personalized identifier corresponding to the message so that the message can be prioritized correctly.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 98,99,106-108,113 and 114 are rejected under 35 U.S.C. 102(b) as being anticipated by Scannell US Patent 5,377,354.

As per claim 98:

Scannell teaches of a method for an electronic communications message system (fig. 1) to prioritize an information message (abstract; col. 2, lines 36-37, 49-62) comprising:

determining a personalized identifier (sender field identifier) corresponding to the message, (col. 5, lines 32-39); wherein the personalized identifier does not require coordination between a user of the method and an originator of the message, (col. 7, lines 38-49);

locating the personalized identifier in a database, (col. 7, lines 38-42; the comparator 52 locates the sender identifier in the sender-list field database that matches the received sender message);

assigning from the database a code (1 – highest priority through 5 – lower priority) corresponding to the personalized identifier, (col. 6, lines 65-68); and

depositing the message into at least two of a plurality of virtual mailboxes (in-tray 16, FLDR-1-17, FLDR-2-18) wherein the message is prioritized within such virtual mailboxes based on the code, (col. 2, lines 21-27; col. 8, lines 14-18).

As per claims 99,108 and 114:

Scannell teaches of wherein the database, the personalized identifier, the code, and the correlation between the personalized identifier/identity code and the (priority) code and the code are initially defined by a user and subsequently changeable by said user, (col. 6, lines 9-17; the user can set up rules that are used to prioritize the messages).

As per claims 106 and 107:

Scannell teaches a system for prioritizing a received information (abstract) message, comprising:

a database, (rules store 12);

a plurality of known personalized identifiers stored in the database, (col. 6, lines 18-22,27-30; fig. 2; the personalized identifiers represent the identity of the senders);

a plurality of identity codes, wherein each of the known personalized identifiers is associated with one of the plurality of identity codes, (col. 6, lines 65-68; the user assigns a priority level based on the sender/personalized identifier);

a computing device (rules test unit) for determining a first personalized identifier associated with a received information message, (col. 5, line 65-col. 6, line 3) wherein the first personalized identifier is not dependent upon coordination between a user of the system and an originator of the received information message;

a priority assignment device for assigning a priority code to the received information message corresponding to the identity code associated with any matched first personalized identifier, (col. 9, lines 23-30); and

a prioritizer to prioritize the message according to the priority code, (col. 2, lines 21-27; ; col. 6, lines 65-68; col. 8, lines 9-19; col. 9, lines 23-30); and

a plurality of virtual mailboxes wherein the message is prioritized within such virtual mailboxes based on the priority code in at least two of the priority of mailboxes, (col. 8, lines 9-18)

As per claim 113:

Scannell teaches a computer-readable medium of instructions and data, comprising:

a received message, (abstract; col. 3, lines 37-39);

a personalized identifier corresponding to the received message (block 26 (sender) of message 25; fig. 2), wherein the personalized identifier does not require coordination between a user of the medium and an originator of the received message, (col. 7, lines 38-49);

computer instructions for receiving the message and the personalized identifier, (col. 3, lines 39-49);

a database (Rules store 12; figs. 1 and 2) containing known personalized identifiers, each personalized identifier associated with a code of a plurality of codes, (col. 6, lines 18-22);

computer instructions for correlating the received personalized identifier with a known personalized identifier, (col. 7, lines 38-45); and

computer instructions for prioritizing the message according to the priority code associated with the correlated known personalized identifier, (col. 6, lines 65-68; abstract).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 100,109 and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Larson et al. US Patent 6,408,068, (hereinafter Larson).

As per claims 100,109 and 115:

Scannell, as applied to above, does not specifically teach wherein the prioritization includes an element of a response device for providing a personalized response to the originator.

Larson teaches of a system which sends personalized responses to the caller depending on their caller identification, (col. 13, lines 39-55). Larson teaches that a user will use custom messages so that specific types of callers such as callers with blocked caller ID or specific people such as relatives can receive a customized message. Blocked caller ID users will receive a general custom message whereas relatives can receive a more personalized message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by having the system provide a personalized response to the sender based on the sender identification as taught by Larson so that the sender, if they are important to the message receiver, can receive a personalized message or if

the identification can determine that the sender is not important then the system can play a general message.

8. Claims 101,104,110 and 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind EP 0825752 A2.

As per claims 101,110 and 116:

While Scannell teaches of the information message being an e-mail message, Scannell does not specifically teach of the information message being a voice mail message.

Rochkind teaches that it was well known in the art to have a system which prioritizes and sorts e-mail messages, voice mail messages and multimedia messages, (page 2, lines 57-page 3, line 10; abstract). The system prioritizes incoming voice mail messages based on personalized rules set by the user such as using an address extension. The sender of a message will indicate an extension which will be used by the receiver's system to determine what priority the message should receive, (page 5, table 2). The message is then stored in the mailbox according to the priority code.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by prioritizing voice mail messages as taught by Rochkind so that a user can prioritize all of their incoming voice, email and multimedia messages.

As per claim 104:

While Scannell teaches wherein the elements of the method are performed by a computer-automated system, Scannell does not specifically teach of wherein the elements are

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performed by an automated system selected from the group consisting of: a computer, a voice-type message storage device or a facsimile machine.

Rochkind teaches that it was well known in the art to have the method being performed by an automated system selected from the group consisting of: a computer, a voice-type message storage device, a facsimile machine, a combination of any two of the foregoing, and a combination of the first three of the foregoing, (page 2, lines 57-page 3, line 10; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Scannell by using a voice-type message storage device or a facsimile machine as taught by Rochkind so that a user can prioritize all of their incoming voice, email and multimedia messages and can determine what messages are important without having to read or listen to all of the messages..

9. Claims 102,111 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind and further in view of Epstein et al. US Patent 6,327,343.

As per claims 102,111 and 117:

While Scannell and Rochkind teach wherein the personalized identifier is derived from the identification of the sender, Scannell and Rochkind do not specifically teach of wherein the personalized identifier is derived from a voiceprint of an audio element associated with the voice mail message or is a biometric signature associated with the originator and the information message.

Epstein teaches that it was well known in the art to use voiceprint/voice recognition to derive a personalized identifier from the received message and to prioritize the message based upon the derived information, (col. 5, lines 8-27,52-65;col. 9, lines 57-67). Epstein also teaches

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of associating a biometric signature (voiceprint) with the originator, (col. 5, lines 8-27; fig. 3B-step 210; col. 9, lines 12-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by employing the use of biometrics which include at least using voiceprints for identifying the sender of the incoming message as taught by Epstein so that the sender can still be identified if the caller ID was not received by the system.

10. ~~Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind and further in view of Larson.~~

As per claim 103:

Scannell and Rochkind, as applied to above, do not specifically teach wherein the prioritization includes an element of providing a personalized response to the originator based on the personalized identifier and the priority code.

Larson teaches of a system which sends personalized responses to the caller depending on their caller identification, (col. 13, lines 39-55). Larson teaches that a user will use custom messages so that specific types of callers such as callers with blocked caller ID or specific people such as relatives can receive a customized message. Blocked caller ID users will receive a general custom message whereas relatives can receive a more personalized message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by having the system provide a personalized response to the sender based on the sender identification as taught by Larson so that the sender, if they are important to the message receiver, can receive a personalized message or if

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the identification can determine that the sender is not important then the system can play a different message.

11. Claims 105,112 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Epstein et al. US Patent 6,327,343.

As per claims 105,112 and 118:

While Scannell teaches wherein the personalized identifier is derived from the identification of the sender, Scannell does not specifically teach of wherein the personalized identifier is derived from a voiceprint of an audio element associated with the voice mail message or is a biometric signature associated with the originator and the information message.

Epstein teaches that it was well known in the art to use voiceprint/voice recognition to derive a personalized identifier from the received message and to prioritize the message based upon the derived information, (col. 5, lines 8-27,52-65;col. 9, lines 57-67). Epstein also teaches of associated a biometric signature with the originator, (col. 5, lines 8-27; fig. 3B-step 210; col. 9, lines 12-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by employing the use of biometrics which include at least using voiceprints for identifying the sender of the incoming message as taught by Epstein so that the sender can still be identified if the caller ID was not received by the system.

Response to Arguments

12. Applicant's arguments filed August 11, 2005 have been fully considered but they are not persuasive.

Rejections Based Upon 35 U.S.C. §102(b)

As per claims 98, 106 and 113:

Applicants maintain that the claim limitation “depositing the message into at least two of a plurality of virtual mailboxes wherein the message is prioritized within such virtual mailboxe[s] based upon the code” states that the message is within the mailbox when being prioritized and that the prioritization is based upon a “code corresponding to a personalized identifier” rather than a priority code. The Examiner respectfully disagrees.

As previously stated in the last office action, the Examiner believes that two outcomes must occur with the limitation “depositing the message into at least two of a plurality of virtual mailboxes wherein the message is prioritized within such virtual mailboxes based on the code” in order for there to be anticipation. First, a message must be deposited into at least two virtual mailboxes and second, the message in the mailbox must be prioritized based on a code. The Examiner believes that as long as the message in the virtual mailbox is deposited and is prioritized according to a code then, anticipation has occurred. The Examiner would like to point out that there is no specific limitation stating that the message cannot be prioritized before being deposited nor there is any limitation reading that the process of prioritizing the message occurs only after the message has been deposited.

The Applicants maintain that since the claims state, “wherein the message is prioritized within such mailboxes based on the code” then the message is prioritized within the mailbox. While this can be seen as one possible scenario the Examiner, as previously stated, maintains that this limitation is broad enough to read on prioritizing before being deposited and having the message being in prioritized order within the mailbox. Both of these scenarios clearly meet the limitation since the message is arranged according to priority within the virtual mailbox.

Scannell et al. US Patent 5,377,354l:

Given the prior art Scannell, the Examiner believes that since the messages are deposited and are prioritized in the mailboxes of Scannell, then the claims read on the prior art.

The Examiner would like to also explain in detail how Scannell reads on depositing the message into at least two of a plurality of virtual mailboxes wherein the message is prioritized within such virtual mailboxes based on the code. As shown in col. 8, lines 5-19, rules are matched based on the fields of the received message so that a priority can be assigned to the message. Scannell then states that the message along with the priority code is deposited into a mailbox and any other mailbox.

The Examiner presents this scenario utilizing the method of Scannell; first, if a first message has a low priority code it is deposited into the mailbox along with its code. If a second message also has a low priority code then it is also deposited along with its code. If, a third message arrives which has a high priority then that message when deposited will be put on top of the list since higher priority messages must be heard first. Hence, based on the message priority code, the messages are prioritized within the mailbox after being deposited since the higher prioritized message is prioritized before the lower prioritized message.

The Applicants comment that there is some confusion about the difference between “prioritizing” a message and “sorting” a message based upon a priority code. Applicants state that prioritizing includes both the assignment of a priority code and the sorting. The Examiner agrees with the Applicant. Based upon the standard definition of prioritize which is: to arrange or deal with in order of importance and sort which is to arrange according to class, kind, or size; classify, then it is clear that sorting according to a “class or kind” (priority code) reads on

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prioritization. Therefore, taking this further analysis, since Scannell also teaches sorting a message within a mailbox after assigning a priority code, then Scannell reads on prioritizing the message within the mailbox.

Applicants contend that Scannell is directed to sorting a message within a mailbox after assigning a priority code and prior to insertion into any mailbox and thus Scannell is only sorting, not prioritizing, within the mailbox. The Examiner respectfully disagrees.

As stated above in the rejection and in col. 2, lines 21-27, Scannell provides at least a method and system which perform an automatic sorting and prioritizing of the messages in the in-tray (1st virtual mailbox), so that, for example, the user can deal with those messages of the highest priority first, selectively in their entirety, regardless of the chronological order in which the messages arrived at the user's location. Therefore, Scannell teaches the prioritization of messages in at least a first virtual mailbox wherein messages are automatically sorted and prioritized within such virtual mailbox.

Scannell also teaches in col. 8, lines 9-19, when the message has been matched against all rules of the rule set, the actions stored in the actions storage unit 54 are matched against each other, to eliminate duplications of file-tos and forward-tos and to select the highest of whatever priorities have been assigned to the message. The actions are then carried out; the message is filed in the in-tray with the appropriate priority appended to it and in any further appropriate folders (2nd virtual mailbox) and forwarded to the appropriate addressees (if any).

Therefore, Scannell at least teaches that messages are sorted and prioritized in both the in-tray mailbox and at least one other mailbox.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any response to this action should be mailed to:

Commissioner for Patents
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Or:

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Hand-delivered responses should be brought to:

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Alexandria, VA 22314

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
October 20, 2005

O.E./oe